## REMARKS

I. Amendments to the Specification

The Specification was amended to update the status of the parent applications.

II. Comments regarding restriction requirement

Claims 24, 27, 29, 38 and 39 are method of use claims which depend from product claim10. Applicants reiterate that upon allowance of product claim 10, there should be rejoinder of "method of use" claims 24, 27, 29, 38 and 39 in accordance with the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)." Further given such provision for rejoinder, Applicants respectfully submit that it would not be unreasonable or an undue burden on the Examiner to examine those claims at this time. Applicants expressly reserve the right to petition the restriction requirement if the full scope of the claims is not considered.

III. Objections to the Specification

The Examiner has objected to the Specification for allegedly failing to provide proper antecedent basis for the claimed subject matter. The Examiner has specifically stated that "[t]here does not appear to be clear antecedant basis for each of the individual method steps of claims 30 and 33; and therefore for the products of claims 31-32 and 34-35 produced by the methods of claims 30 and 33" (10/11/02 Office Action, paragraph 9, page 3).

Applicants respectfully traverse this objection. Originally filed claims 30 and 33 are believed to be fully supported by the instant application. However, in order to expedite prosecution of this application, and solely for purposes thereof, claims 30 and 33 have been amended. Exemplary support for amended claims 30 and 33 can be found in the Specification at page 28, lines 1-8 and lines 20-25; and page 29, lines 17-23.

Claim 28 was objected to "under 37 CFR 1.75(c), as being of improper dependant form for failing to further limit the subject matter of a previous claim." (10/11/02 Office Action, page

3.) The Examiner alleged that "[t]he specification does not appear to encompass labeled antibodies" and "[t]hus an antibody that is labeled is broader in scope than the antibody in the composition of claim 26." (10/11/02 Office Action, page 3.) On the contrary, the Specification discloses labeled antibodies (e.g. at page 35, line 26 through page 36 line 3).

The Examiner has also objected to the Specification in regard to Claims 10, 25-26, 28 and 30-37. Specifically the Examiner has stated that "Claims 10, 25-26, 28 and 30-37 are objected to as either directly or indirectly depending from non-elected claim 1."(October 11, 2002 Office Action, page 3, paragraph 11). This objection has been addressed by the amendment to claim 10, which has put claim 10 in independent form.

Accordingly, withdrawal of the objection to the Specification is respectfully requested.

IV. Enablement rejection under 35 U.S.C. § 112, first paragraph

Claims 10, 25, 26, 28 and 30-37 stand rejected under 35 U.S.C. § 112, first paragraph based on the allegation that the Specification does not describe the subject matter of the invention in such a way as to enable one of skill in the art to make and/or use antibodies which specifically bind to the recited "variants" and "fragments" of SEQ ID NO:1 (October 11, 2002 Office Action, pages 3-4, paragraph 13).

Applicants submit that the Specification provides an enabling dislosure for the full scope of original claims 10, 25, 26, 28 and 30-37. Nevertheless, in the interest of expediting prosecution of the subject application, independent claim 10 has been revised to recite "an isolated antibody which specifically binds to a polypeptide comprising the amino acid sequence of SEQ ID NO:1." Applicants expressly do not disclaim equivalents of the claimed subject matter. Withdrawal of this rejection is therefore requested.

V. Written description rejection under 35 U.S.C. § 112, first paragraph

Claims 10, 25, 26, 28 and 30-37 are rejected under 35 U.S.C. § 112, first paragraph as being based on a specification which allegedly fails to reasonably convey to one of skill in the art that the Applicants had possession of the claimed invention at the time the application was filed. The Examiner specifically states that " The instant claims are drawn to an extensive genus of antibodies to proteins having highly diverse structures and functions for which Applicants does

not appear to have provided a representative number of species" (10/11/02 Action, page 5, paragraph 14).

Applicants submit that the Specification provides an adequate written description of original claims 10, 25, 26, 28 and 30-37. Nevertheless, in the interest of expediting prosecution of the subject application, independent claim 10 has been revised to recite "an isolated antibody which specifically binds to a polypeptide comprising the amino acid sequence of SEQ ID NO:1." Applicants expressly do not disclaim equivalents of the claimed subject matter. Withdrawal of this rejection is therefore requested.

VI. Rejections under 35 U.S.C. § 102 and § 103

Claims 10, 26, 28 and 30-32 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Liu et al." (J. Biol. Chem., 272(21): 13779-13785, 1997). Additionally, 35 U.S.C. § 103 rejections of claims 10, 25, 26, 28 and 33-37 have been applied over Liu et al., in combination with Zola (Monoclonal Antibodies: A Manual of Techniques, CRC Press, Florida, 1987) and Ramakrishnan et al. (U.S. Patent No. 5,817, 310).

It is believed that the subject matter encompassed by the original claims is allowable over the applied art. Nevertheless, in the interest of expediting prosecution of the subject application, independent claim 10 has been revised to recite "an isolated antibody which specifically binds to a polypeptide comprising the amino acid sequence of SEQ ID NO:1." Applicants expressly do not disclaim equivalents of the claimed subject matter.

None of Liu et al., Zola or Ramakrishnan et al. describe such claimed antibodies. Withdrawal of the 35 U.S.C. § 102 and § 103 rejections is therefore requested.

**CONCLUSION**

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact Applicants' Attorney at (650) 855-0555.

Applicants formally petition for a one month extension of time for reply, please charge the required fee and any other fee including extension of time fees under 37 CFR § 1.17 to Deposit Account No. **09-0108**.

Respectfully submitted,

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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

## IN THE TITLE

Please replace the title beginning at page 1, line 1 has been amended as follows.

ANTIBODIES TO HUMAN PEROXISOMAL THIOESTERASE

## IN THE SPECIFICATION:

Paragraph(s) beginning at line 2 of page 1 has been amended as follows:

This application is a divisional application of U.S. application serial number 09/265,294, filed March 9, 1999, now U.S. Patent No. 6,210,890, which is a divisional application of U.S. application serial number 09/100,851, filed June 19, 1998, now U.S. Patent No. 5,911,984, which is a divisional of U.S. Application Serial No. 08/872,784, filed June 11, 1997, now U.S. Patent No. 5,776,753.

## IN THE CLAIMS:

Claims 1, 11 and 22 have been cancelled.

Claims 10, 30 and 33 have been amended as follows:

10. (Amended) An isolated antibody which specifically binds to a polypeptide [of claim 1] comprising the amino acid sequence of SEQ ID NO:1.

30. (Amended) A method of preparing a polyclonal antibody with the specificity of the antibody of claim 10 comprising:

a) immunizing an animal with a polypeptide of SEQ ID NO:1 or an immunogenic fragment thereof under conditions to elicit an antibody response; and

b) [isolating antibodies from said animal; and

c)] screening [the isolated] for antibodies with the polypeptide thereby identifying a polyclonal antibody which binds specifically to a polypeptide of SEQ ID NO:1.

33. (Amended) A method of making a monoclonal antibody with the specificity of the antibody of claim 10 comprising:

a) [immunizing an animal with] using a polypeptide of SEQ ID NO:1, or an immunogenic fragment thereof [under conditions to elicit an antibody response], to make antibody-producing hybridoma cells; and

b) [ isolating antibody producing cells from the animal;

c) fusing the antibody producing cells with immortalized cells to form monoclonal antibody-producing hybridoma cells;

d) culturing the hybridoma cells; and

e) isolating from the culture] screening for antibodies with the polypeptide, thereby identifying a monoclonal antibody which binds specifically to a polypeptide of SEQ ID NO:1.